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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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L. Michael Maritzen

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EXAMINER

HOLZEN, STEPHEN A

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/930,608	MARITZEN ET AL.	
	Examiner	Art Unit	
	Stephen A. Holzen	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 9-13 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-7, 9-13 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/3/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

- 1) Applicant's arguments filed 1/20/2006 have been fully considered but they are not persuasive.
- 2) Applicant simply amended claim 13 to put the phrase "a task" in front of the functional words: "determining" and "using". The phrase "a task" is still a statement of intended use. While the examiner has reconsidered his position on 35 USC 112, and believes that applicant's claim language is definite, the examiner also asserts that the phrases "a task of determining" and "a task of using" are merely functional phrases that do not limit the scope of the apparatus in any structural sense. (see paragraph #5 below)
- 3) Applicant has not satisfied the examiner requirement to specifically list what all is meant and encompassed by the "means for" language. It is unclear from the specification what all is meant and encompassed by the "means for language".
- 4) Re – Claims 20-24: Applicant has argued computer implemented apparatus are definite, and the examiner agrees with this assertion. The claim language (as defined in the office action mailed on 10/20/2005) is therefore entirely functional. (see paragraph #5 below)

5) Applicant's functional language, in the claims, does not serve to impart patentability.

While features of an apparatus may be recited either structurally or functional, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitation of the claims. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d, 1429, 1431-.2 (Fed. Cir. 1997); Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); Ex parte Masham, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

6) Applicant has asserted that credit cards reveal the identity of an account holder to the supplier. Arguments of counsel may be effective in establishing that an examiner has not properly met his or her burden or has otherwise erred in his or her position. In these situations, an examiner may have failed to set forth any basis for questioning the adequacy of the disclosure or may not have considered the whole specification, including the drawings and the written description. However, it must be emphasized that arguments of counsel alone cannot take the place of evidence in the record once an examiner has advanced a reasonable basis for questioning the disclosure. See In re Budnick, 537 F.2d at 538, 190 USPQ at 424; In re Schulze, 346 F.2d 600, 145 USPQ 716 (CCPA 1965); In re Cole, 326 F.2d 769, 140 USPQ

230 (CCPA 1964). The applicant has not produced any evidence in the record that establishes that the use of a credit card identifies the identity of (1) the account holder (2) the purchaser. Until the applicant provides evidence for both situation above, the examiner will not be persuaded by applicant's opinion concerning Visa's business model.

7) If applicant does not traverse the examiner's assertion of official notice or applicant's traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP 2144.03). The applicant has failed to traverse the examiner's assertion of official notice, therefore the common knowledge assertions by the examiner are taken to be admitted prior art. (Please see examiner's assertions on pages 5 and 6 of the detailed action mailed on 10/20/2005).

8) Applicant has attempted to amend the claims such that they would not be obvious in view of the admitted prior art. Specifically the applicant has amended the claim to require that the identity of an account holder would not be revealed when that party's credit card is used. This is completely different than the previous limitation, which required the identity of the purchaser to remain anonymous. The examiner has

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already advanced the reasoning that it need not be the account holder who is using the account to purchase goods, and therefore the purchaser remains anonymous.

The examiner's rejection was silent with respect to the anonymity of the account holder, and only was concerned with the party initiating the transaction. There was good reason for his silence: the applicant did not disclose in the specification that the party initiating the purchase actually be the party who holds the account. In fact the applicant is silent with respect to whom the account belongs to.

See in the present disclosure:

¶0010: "The product or the service is purchased without disclosing the identity of the party."

¶0019: "...the intelligent agent prepares a request on behalf of the user (also referred to herein as a party or a consumer) of client 101..."

¶0024: "A party includes a person, a group of individuals, an organization or other suitable entity".

¶0024-0025: "In order to obtain the best deal available to the user, the intelligent agent is configured to use conventional means to provide the user's(or the party's) personal information to the supplier(s) or to provide information to the supplier that allows the user to benefit from pricing policies of the supplier. Personal information is defined as information that affects the party. Personal information includes, for example, financial information, past transactional information, elements of potential future transactions, or other suitable information.

¶0037: The applicant provides examples of privacy levels. None of the examples withholds the identify of the account holder, only the identity of the purchasing party.

The examiner could not find a single instance in the disclosure where the applicant defines or suggests that the word "party" (or "user") is defined as the account holder. Instead applicant has used the word "party" (and "user") in the context of the

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person actually doing the purchasing. The examiner concludes therefore that applicant's original disclosure is not concerned with anonymity of the account holder, but instead the purchaser. Therefor the examiner asserts that the phrase "without revealing to the supplier an identity of the party whose financial account is associated with the transaction device" is new matter.

Claim Rejections - 35 USC § 103

9) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10) Claims 2-7, 9-13, 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter (5,926,798) in view of Low et al (5,420,926) and further in view of admitted prior art.

Re – Claims 6, 13, 24: Carter discloses a computer implemented method in which at least one intelligent agent negotiates the purchase of a product or service on behalf of a party (see Col. 2, lines 54+), the computer implemented method comprising:

configuring the at least one intelligent agent to determine whether one of the products and services offered by a supplier satisfies preferences established by the party (303),

dispatching the at least one intelligent agent from a client to a service (see Col. 2, lines 54+),

using the at least one intelligent agent to customize the price for one of the product and the service using one of the personal data associated with the part and at least one arbitrary pricing policy (see "Negotiate Deals" in Col. 2, lines 67)

authorizing, by a transaction device (credit card), the at least one intelligent agent to anonymously purchase (credit cards used over the internet are anonymous) one of the product and the service from the supplier, the transaction device providing the authorization through the VISA network (i.e. a transaction privacy clearing house (TPCH)) without revealing an identity of the party using the transaction device to the supplier. Carter uses a credit card to authorize a credit card clearinghouse network (such as VISA) to authorize the financial transactions between the buyer and the seller.

Carter does not specifically disclose that the use of a a credit card network is anonymous, thus Carter does not specifically teach that it is known to withhold the name of party to whom the financial account is associated.

Low et al teach a communications exchange to pass information between the parties of the transaction and the use of encrypted messages in which a party to the transaction or the communications exchange can read only that information which is required for the party's or the information exchange's part in

the transaction. (see Col. 8, lines 47-65) Anonymity is achieved in the credit card transactions of the invention by encrypting the messages required for the transaction such that the involved parties can read only the information required for their parts in the transaction and by sending the messages by means of a communications exchange, so that a party receiving a message does not know the source of the message. (see col. 2, lines 3-9)

It would have been obvious to one having ordinary skill in the art, at the time the invention was made to withhold the name of the party to whom the financial account is associated to prevent government agencies and large corporation from tracking a person's purchasing habits.

Carter does not disclose using historical purchase activity of the party, a potential future purchase activity of the party, or a group to which the party is a member to negotiate price.

Using personal data to negotiate a purchasing price is well known in the art to be useful in obtaining price reductions. (Sam's Club is one example of the above claimed subject matter). Since applicant has not specifically traversed the examiner's official notice, the applicant has therefor admitted that using personal data to negotiate a purchasing price is well known in the art to be useful in obtaining price reduction. It would have been obvious to reward the purchaser

with better prices based on group memberships and potential future purchase activity, to build a relationship between customer and sellers.

Re – Claim 3, 10, 21: Carter discloses that intelligent agents register the buyers with the supplier without the buyer's active involvement. (see Col. 9, lines 9-11: steps 306-308).

Re – Claim 4, 11, 22: Carter discloses that intelligent agents perform data mining operations (Col. 5, lines 31-33).

Re – Claim 5, 12, 23: Credit card clearing house networks are secure links between customer, suppliers and financial institutions that are based upon at least one preference established by the party (i.e. VISA, MC or DISCOVER network).

Re – Claim 7: The intelligent agent compares prices of one supplier with those of a second supplier.

11) Claims 2, 9, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carter as applied to claims 6, 13, and 24 above, and further in view of admitted prior art. Carter does not disclose using the size of a purchase as a negotiating chip or incentive to obtain a lower per unit sales price. However, it is well known in the art

that purchasing a product or service in bulk provides the buyer a stronger negotiation position resulting in lower prices. Sam's Club is again an example of this interaction. Buyers are required to buy their purchases in large bulk, however they are rewarded for their continual patronage (i.e. membership) and bulk purchases with lower per product prices. Applicant has not specifically traversed the examiner official notice and therefore these "well known" facts are now considered admitted prior art. It would have been obvious to use bulk purchasing as a price negotiating position in order to save money.

Claim Rejections - 35 USC § 112

- 12) Claims 2-7, 9-13, 20-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant amended the independent claims to add the limitations concerning the withholding of the identity of an account holder. These limitations are not supported by the originally filed specification.
- 13) The amendment filed 1/20/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The

added material which is not supported by the original disclosure is as follows: --
withholding the identity of an account holder--.

Applicant is required to cancel the new matter in the reply to this Office Action.

Conclusion

14) It should be appreciated that the applicant's functional language in the claims do not serve to impart patentability. While features of an apparatus may be recited either structurally or functional, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Apparatus claims cover what a device is, not what a device does. A claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior apparatus teaches all the structural limitation of the claims. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-.2 (Fed. Cir. 1997); Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990); Ex parte Masham, 2 USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

15) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen A. Holzen whose telephone number is 571-272-6903. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sah

A handwritten signature in black ink, appearing to read "Peter M. Poon". The signature is fluid and cursive, with the first name "Peter" being more prominent than the last name "Poon".

PETER M. POON
SUPERVISORY PATENT EXAMINER

4/3/06